UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,811	09/15/2003	Guy Nathan	2302-16	7387

23117 7590 08/14/2008

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
MURDOUGH, JOSHUA A	
ART UNIT	**PAPER NUMBER**
3621	
MAIL DATE	**DELIVERY MODE**
08/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,811	NATHAN ET AL.	
	Examiner	Art Unit	
	JOSHUA MURDOUGH	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-79* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-79* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 April 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicant's amendment filed 7 April 2008 has been entered.

2. The new drawings are much more readable and are accepted in spite of Applicants statement that "[n]ow new matter has been introduced." (Page 10 of Applicants' 7 April 2008 submission) The Examiner notes that the previous figures have been redrawn with nothing added. Applicants' statement has been taken as a typo.

3. Claims 1-42 have been canceled.

4. Claims 43-79 are pending and have been examined.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

6. "second display configured to enable a user to select the instance of media for playback" in at least claim 71.

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 71-79 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification nor the drawings disclose the presence of multiple displays as claimed in at least claim 71. Applicants are required to show clear support for this feature or remove it from their claims.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 51 and 69-79 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 51 and 69 recite "each instance of media in the second plurality of instances of media is encrypted with a second layer of encryption." However, there is no first layer of encryption ever shown to be applied to the second plurality of instances of media. Therefore, the Examiner interprets "second" in this instance as a label not as showing an actual count.

12. Claim 79 recites "wherein the first and second displays are each configured to allow a user to supply an additional fee or number of credits." One of ordinary skill in the art would not understand how the fee is supplied though the display. For prior art purposes only, the Examiner

has interpreted this as meaning that an option is presented on the display, when selected, the jukebox device accepts bills or coins.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 43-45, 47-49, 53-55, 57-63, and 65-67 are rejected under 35 U.S.C. §102(b) as being anticipated by Knowles (US 5,481,509).

15. As to claim 43, Knowles shows:

a. A jukebox device **5**, comprising:

b. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media (Figure 4A, step 120) available for playback via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

c. a second storage location (Figure 2, middle element 52) storing a second plurality of instances of media (Figure 4A, step 120) available for playback via the jukebox device for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being higher than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower); and

d. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the

first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5),

e. wherein the first storage location is different from the second storage location (top/middle 52 in Figure 2).

16. As to claim 44, Knowles further shows:

f. the first and second storage locations respectively comprise first and second disk drive devices(Id.).

17. As to claim 45, Knowles further shows:

g. the first and second storage locations respectively are located on first and second areas of a single disk drive device (Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

18. As to claim 47, Knowles further shows:

h. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

19. As to claim 48, Knowles further shows:

i. the first and second storage locations are updatable independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown

as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

20. As to claim 49, Knowles further shows:

j. a selected instance of media from said second plurality of instances of media becomes at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

21. As to claim 53, Knowles shows:

k. A digital audiovisual distribution network, comprising:

l. a plurality of jukebox devices respectively located at a plurality of locations; and

m. a central server **100** operably connected to a repository **112** of instances of media distributable to the jukebox devices via the network (Column 5, lines 51-61);

n. wherein each said jukebox device (Figure 2) comprises:

o. a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

p. a second storage location (Figure 2, middle element 52) storing a second plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being higher than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower); and

q. a user interface (Figure 5, element 200) provided to the jukebox device configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5),

r. wherein the first storage location is different from the second storage location.

22. As to claim 54, Knowles further shows:

s. the first and second storage locations respectively comprise first and second disk drive devices (top/middle 52 in Figure 2).

23. As to claim 55, Knowles further shows:

t. the first and second storage locations respectively are located on first and second areas of a single disk drive device (Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

24. As to claim 57, Knowles further shows:

u. the second plurality of instances of media substantially mirrors the repository of instances of media operably connected to the central server (Column 5, lines 21-33).

25. As to claim 58, Knowles further shows:

v. the first and second storage locations are updatable via the network independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

26. As to claim 59, Knowles further shows:

w. an instance of media from said second plurality of instances of media selected for playback is at least temporarily available on the first storage location (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

27. As to claim 60, Knowles further shows:

x. an instance of media stored in the repository of the central server, subsequent to user request, is downloadable to a storage location of one said jukebox device (Column 5, lines 21-33) for a third fee or number of credits (as evidenced by Figure 4A, step 136), the third fee or number of credits being higher than the second fee or number of credits (multiple prices are disclosed, if there are 3 prices, one is going to be the highest, one will be the middle, and one will be the lowest).

28. As to claim 61, Knowles shows:

y. A method of operating a jukebox device, comprising:

z. providing a first storage location (Figure 2, top element 52) storing a first plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a first fee or number of credits (as evidenced by Figure 4A, step 136);

aa. providing a second storage location (Figure 2, middle element 52) storing a second plurality of instances of media available for playback (Figure 4A, step 120) via the jukebox device for a second fee or number of credits (as evidenced by Figure 4A, step

136), the second fee or number of credits being higher than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower); and

bb. receiving, via a user interface provided to the jukebox device (Figure 5, element 200), user input corresponding to a selection of an instance of media available for playback from the first and second pluralities of instances of media for playback on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5),

cc. wherein the first storage location is different from the second storage location (top/middle 52 in Figure 2).

29. As to claim 62, Knowles further shows:

dd. the first and second storage locations respectively comprise first and second disk drive devices (Id.).

30. As to claim 63, Knowles further shows:

ee. the first and second storage locations respectively are located on first and second areas of a single disk drive device Column 1, lines 60-62 shows that there may be only one drive, and Figure 4A, steps 120 and 124 show separating the content, therefore, separate locations on the same drive is shown.).

31. As to claim 65, Knowles further shows:

ff. at least some said instances of media in the second plurality of instances of media are not included in the first plurality of instances of media (using the division based on music and video, there would be no overlap as it is by the type of media; Figure 4A, step 120).

32. As to claim 66, Knowles further shows:

gg. updating the first and second storage locations independent of one another (as there is no disclosure of anything binding the drives together and they are clearly shown as being updateable; Column 3, lines 33-43; the Examiner's position is that they can be updated independently).

33. As to claim 67, Knowles further shows:

hh. making available on the first storage location, at least temporarily, a selected instance of media from said second plurality of instances of media (wherein the first location contains "New Video Releases" **208** and the second is the whole collection of "Video[s]" **202**; new releases are not new forever, therefore, the position in the new release section is temporary, Figure 5).

Claim Rejections - 35 USC § 103

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35. Claims 71-79 rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Shneidlman (US 2006/0038794).

36. As to claims 71, 74, 76, and 77, Knowles shows:

ii. A jukebox device **5** configured to playback an instance of media selected by a user ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5), comprising:

jj. at least one storage location **52** configured to store instances of media available for playback via the jukebox device (Figure 4A, step 120), the instances of media being divided into first and second subsets of media, the first and second subsets of media being different from one another (Figure 4A, steps 120 and 124); and

kk. a user interface provided to the jukebox device configured to enable a user to select an instance of media from the instances of media in order to initiate playback of the selected instance of media on the jukebox device ("Touch the title of your choice" and various separated indexes of music, video, karaoke, etc., Figure 5),

ll. the user interface comprising a first display configured to enable a user to select the instance of media for playback from the first subset of media **18** for a first fee or number of credits (as evidenced by Figure 4A, step 136), and

mm. the display configured to enable a user to select the instance of media for playback from at least the second subset of media (Figure 4A, step 120) for a second fee or number of credits (as evidenced by Figure 4A, step 136), the second fee or number of credits being greater than the first fee or number of credits (multiple prices are disclosed, one has to be higher and one has to be lower).

37. Knowles does not expressly show a "second display configured to enable a user to select the instance of media for playback" or that the list of media is searchable.

38. However, Shneidlman shows the use of multiple touchpads (Paragraph [0096]) in conjunction with "multi-searchable jukebox type applications" (Paragraph [0063]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to include a second touch screen and a search, as taught by Shneidlman, in order to allow two users to access the system simultaneously and provide users with an easier method of accessing the media.

39. As to claim 72, Knowles further shows:

nn. the first display includes a list of artists for each said instance of media in the first subset of media ("Touch here to sort by title or artist" Figure 5).

40. Knowles in view of Shneidlman teaches a list of artists being displayed on a jukebox. However, it does not expressly teach the specific data recited in claim 73 (the album art). Nevertheless, the difference(s) are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP • 2106.*

41. As to claim 75, r1 fshows

oo. the second display is configured to display search results **220** after at least some instances of media not included in the first subset of media are searched for instances of media matching the search criteria.

42. As to claim 78, Knowles further shows:

pp. the search results are selectable by the user in order to initiate playback of the selected search result by the jukebox device for the second fee or number of credits (as evidenced by Figure 4A, step 136).

43. As to claim 79, Knowles further shows:

qq. the first and second displays are each configured to allow a user to supply an additional fee or number of credits in order to make the selected instance of media play immediately after a currently playing instance of media (through element 20).

44. Claims 46, 56, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles in view of Official Notice.

45. Knowles shows as discussed above in regards to claims 43, 53, and 61; but does not expressly show:

rr. the first and second storage locations respectively comprise first and second partitions of a single disk drive device of the jukebox device.

46. The Examiner takes Official Notice that it is notoriously old and well known in the art to create partitions on a hard drive to separate data of different types in order to prevent complete failure of the hard drive. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to create a formal separation on the hard drive, in the form of partitions in order to isolate each type of file. This way, if one File Allocation Table (FAT) became corrupt, the data on the entire hard drive was not lost but only one partition.

47. Claims 50, 51, 68, and 69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles in view of Bowman-Amuah (US 6,289,382).

48. Knowles shows as described above in regards to claims 43 and 61 but does not show the encryption of the media as claimed in these claims.

49. However, Bowman-Amuah shows the encryption of the media in a jukebox system (Column 90, lines 25-37). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to encrypt the media as shown by Bowman-Amuah in order to prevent unwanted access to the media.

50. Claims 52 and 70 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knowles and Bowman-Amuah as applied to claims 51 and 69 above, and further in view of Dunning (US 7,024,485).

51. The Knowles/Bowman-Amuah combination discloses as discussed above, but does not expressly disclose:

ss. each instance of media in the second plurality of instances of media is missing a predetermined number of bytes, said missing bytes being stored in separate respective locations and being at least temporarily insertable into the respective instances of media to enable playback by the jukebox device.

52. However, Dunning shows a jukebox (Figure 2, 103) that splits the content file (Figure 3A, 2714) and only keeps a portion of it (Figure 3A, 2718). When the complete file is requested, the jukebox receives the other portion of the file (Figure 3C, 2734) and combines it with the part stored on the jukebox (Figure 3C, 2738). It would have been obvious to one of ordinary skill in

the art at the time of the invention to have further modified the teachings of Knowles to include the divided storage of Dunning for reasons including, preventing a complete copy of the file from residing on the jukebox where it could be copied (Dunning, Column 6, lines 24-25).

Response to Arguments

53. Applicant's arguments with respect to claims 43-79 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

54. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

55. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

56. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

57. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

58. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621